

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of:  
Inventor: Migimatsu  
Application No.: 10/047,374  
Filed: January 14, 2002  
Title: SYSTEM AND METHOD FOR  
TRANSMITTING VOICE  
MESSAGES THROUGH THE  
INTERNET

Confirmation No: 7420  
Group Art Unit: 2416  
Examiner: Jain, Raj K.

**BRIEF ON APPEAL**

Mail Stop Appeal Brief - Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

This brief supports the appeal to the Board of Patent Appeals and Interferences in the application identified above.

This brief addresses the issues raised in the final rejection mailed on February 11, 2009 ("Office Action").

An amendment to the claims has been submitted concurrently amending claims 4 and 69 according to the Examiner's suggestions in the Office Action.

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#### **A. REAL PARTY IN INTEREST**

The real party in interest for this application is Eletel, Inc.

## **B. RELATED APPEALS AND INTERFERENCES**

There are no related appeals or interferences.

### **C. STATUS OF CLAIMS**

In the office action mailed on February 11, 2009 ("Office Action"), claims 4 and 69 were objected to, claims 1 and 4 were rejected under 35 U.S.C. 112, first paragraph, and claims 1, 2, 4, 5, 31, 38, 45, 50, 53 – 55, 57, 58 and 62 – 70 were rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent 5,608,786 to Gordon ("Gordon").

Claims 1, 2, 4, 5, 31, 38, 45, 50, 53 – 55, 57, 58 and 62 – 70 stand rejected. Claims 3, 6 – 30, 32 – 37, 39 – 44, 46 – 49, 51, 52, 56 and 59 – 61 have been canceled.

The claims being appealed are claims 1, 2, 4, 5, 31, 38, 45, 50, 53 – 55, 57, 58 and 62 – 70.

#### **D. STATUS OF AMENDMENTS**

An amendment to the claims was submitted on February 10, 2010 which adopts the Examiner's suggestions in the objection to claims 4 and 69. This amendment has not yet been entered.

## **E. SUMMARY OF CLAIMED SUBJECT MATTER**

Independent claim 1 is directed to a system for transmitting voice messages over a network. The voice messages are complete caller communications, such as voice mail messages, and they are transmitted over the network in an asynchronous or non-real time manner. In particular, a voice message is recorded before transmission and it is received before it is played back. Independent claim 1 also recites transmission that is responsive to a caller indication, that is “pushed” over the network rather than waiting for a recipient to request transmission. Independent claim 1 also recites delivery notification for notification of the receipt of a message. Independent claim 1 has no means plus function claim elements.

Dependent claim 68 also recites destination information being received and that information being used to select the second access device. Dependent claim 68 has no means plus function claim elements.

Independent claim 4 is directed to a method for transmitting voice messages over a network. The voice messages are complete caller communications, such as voice mail messages, and they are transmitted over the network in an asynchronous or non-real time manner. In particular, a voice message is recorded before transmission and it is received before it is played back. Independent claim 4 also recites transmission that is responsive to a caller indication, that is “pushed” over the network rather than waiting for a recipient to request transmission. Independent claim 4 also recites notification of the receipt of a message. Independent claim 4 has no means plus function claim elements.

Dependent claim 70 also recites destination information being received and that information being used to select the second access device. Dependent claim 70 has no means plus function claim elements.

## **F. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

(1) Whether claims 1 and 4 are unpatentable under 35 U.S.C. 112, first paragraph.

(2) Whether claims 1, 2, 4, 5, 31, 38, 45, 50, 53 – 55, 57, 58, 62 – 67 and 69 are unpatentable under 35 U.S.C. 102(e) over Gordon.

(3) Whether claims 68 and 70 are unpatentable under 35 U.S.C. 102(e) over Gordon.



## G. ARGUMENTS

### **(1) Rejection of claims 1 and 4 under 35 U.S.C. 112, first paragraph**

In the Office Action, the Examiner rejected claims 1 and 4 based on the limitation of a “complete caller communication.” The Examiner states that the claims contain “subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.” The Examiner further states that “it’s not clear or understood whether complete caller communication is simply a telephone number used for paging, a brief message, a personal or subscriber 10, etc ..” [Office Action at 2]

The applicants assert that this limitation is fully disclosed in the specification and the independent claims 1 and 4 are enabled and definite under 35 U.S.C. 112, first paragraph. When considered in the context of the entire specification and the claims at issue, it is clear that a “complete caller communication” includes a voice message, and that such a voice message is complete in the sense that it is part of an asynchronous rather than real-time interaction. The ordinary interpretation of this phrase would be understood by one of skill in the art and is consistent with and well supported by numerous references in the specification.

In particular, the present application is concerned with transmission of voice messages over a network and it is contrasted with real-time communication. For example in the Background section, the specification characterizes the prior art as follows: “... communication techniques have been proposed to use the Internet as a real time communication means.” [page 2, lines 3-4] As such, the current application teaches one to avoid the limitations of real-time communication by transmitting voice messages. In particular, in the Summary of the Invention section the specification characterizes the invention generally as: “for transmitting and receiving voice messages to a receiver from a caller.” [page 2, lines 19-20, emphasis added]. These voice messages would be understood to constitute complete caller communications.

The specification further characterizes an embodiment of the invention as: “an easy-to-use voice mail and paging system ... a caller can ... leave a voice mail for a receiver at a non-local mailbox using a local call.” [page 3, lines 27 – 29, emphasis added]. Again this characterization would be understood to be a complete caller communication. One of ordinary skill in the art would be familiar with the term “voice mail” and the usage of such technology to convey complete caller communications.

The specification further discusses an embodiment in which “a user ... in the United States ... desires to send a voice mail message to someone in London, England.” [page 7, lines 15 – 17, emphasis added] A voice mail message is understood in this context to be a complete caller communication. Further explanation is provided in an explanation of an embodiment in which a user is prompted to “speak the voice message” and further that the “caller's message is received by the access computer 20 13l through its voice/fax board 33 where it is converted from analog to digital format, creating a message file.” [page 8, lines 1-5] Such description is consistent with use of a complete caller communication in claims 1 and 4, which recite “said digital message file comprises a complete caller communication.”

In addition, the specification describes an embodiment of delivery of a voice message in which “if the telephone 19 is answered by a message recorder, the message is sent as voice mail.” [page 9, lines 17-18] Again a complete caller communication would be understood to be consistent with a voice message and a voice mail system.

The specification also describes and embodiment in which a user transmits a complete caller communication as follows:

“An alternative embodiment 700 allows the caller to place the voice message and the page into the access computer during a single phone connection, as illustrated by FIG. 8. The caller (step 701) calls (step 703) via telephone 507 to a local access computer 13m, for example, without paying for long distance services by the telephone company or the like. The caller waits for the proper prompt on the telephone from the access computer and then accesses the

access computer by entering his/her identification number 705. Upon receiving the proper prompt from the access computer, the caller enters a pager phone number 707 for the receiver. A further prompt from the access computer indicates that a voice mail message is ready to be transmitted by the caller. The caller provides the voice mail message into the access computer by speaking into the telephone (step 709). Details of providing and converting the voice mail message were described in the preceding embodiments. The voice mail message and pager phone number are converted into a digital format for transmission over the Internet 711 to the receiver's voice mail destination.” [page 14, lines 8-21, emphasis added]

In another embodiment, the specification describes the recording and optional re-recording of a voice message, which would be understood as a complete caller communication:

“After entering the destination telephone number (and pager number in some embodiments), the process allows the caller to record a voice message (step 815) to be sent to a voice mailbox in memory of the access computer or other location. Alternatively, the process allows the caller to record a message which will be sent via facsimile to the receiver. Details of recording the voice message are described throughout the specification. If the caller wants to re-record (step 817) the message, a key (e.g., "1") assigned to this function is depressed (step 819) on the telephone, which allows the caller to re-record the message (step 815) via branch 816. Alternatively, the caller presses a key assigned for termination (step 821) of the voice message. Upon terminating the voice message, the phone is placed back on the hook, which also can terminate the message in this process.” [page 16, lines 14 – 25]

In the above description, the user directed termination of the voice message is further clarification of the complete nature of the caller communication, and is consistent with the description of a voice message in the specification. In another example, the

specification discusses a "voice message" and discusses "transferring the voice message to a voice mailbox". [See page 18, lines 8 – 15]

In summary, the phrase "complete caller communication" would be well understood by one of ordinary skill in view of the specification and the claims at issue. There is extensive discussion and numerous examples in the specification of voice messages, voice mail systems, voice mailboxes and digital message files and these would be understood to be examples of complete caller communications. The plain and ordinary meaning of complete caller communication would be understood and is supported by the specification. For at least these reasons, claims 1 and 4 are enabled and definite under 35 U.S.C. 112, first paragraph.

**(2) Rejection of claims 1, 2, 4, 5, 31, 38, 45, 50, 53 – 55, 57, 58, 62 – 67 and 69 under 35 U.S.C. 102(e) over Gordon**

In the Office Action, the Examiner rejected claims 1, 2, 4, 5, 31, 38, 45, 50, 53 – 55, 57, 58, 62 – 67 and 69 as being unpatentable under 35 U.S.C. §102(e) over U.S. Patent 5,608,786 to Gordon ("Gordon").

**Overview of Gordon**

Gordon discloses a messaging system that couples local public switched telephone networks and the Internet. See for example Fig. 1. Gordon utilizes devices referred to as "Unipost Access Nodes" to form a gateway between a phone network and the Internet. See for example Gordon at 4:45 – 67. Gordon discloses that a Unipost Access Node behaves like a conventional voice mail system with respect to the receipt of voice messages to a subscriber. "Thus, to a caller calling a Unipost subscriber from a telephone, the UAN will behave like a voice mail system." [Gordon at 6:4-5] In a conventional voice mail system the caller retrieves their message by dialing into their voice mail box. A conventional voice mail system is coupled to the Public Switched Telephone Network (PTSN) and supports the recording of messages into and playback of messages from a central repository. Such systems do not involve transmission of

voice messages over a network. In addition, such systems rely on voice messages being accessed or played back responsive to the receiver of the message.

Much of Gordon relates to the mechanisms by which subscribers retrieve their own messages remotely. For example Gordon notes that the "... retrieval can be carried out using any of (1) a telephone set which forms a telephone communication with a suitable commercial access providing computer, or (2) a computer and modem which forms a telephone communication with a suitable commercial access providing computer, ..." [Gordon at 2:35-40] Gordon later describes an embodiment that "... includes at least two commercial access providing computers, each interconnected to the Internet, and wherein the subscribers to the system can access either of the two commercial access providing computers for retrieval of communications stored on behalf of the subscriber." [Gordon at 3:10-15] Gordon also notes that: "A computer will facilitate retrieval and management of all message types, including voice, facsimile, E-Mail, video and any other file type. UniPost software resident in the computer will allow for the convenient retrieval, playback, viewing, filing and general management of all message types." [Gordon at 6:15-20] In addition: "The retrieval of messages in the electronic mailbox using a computer and modem shown as 12 can follow the conventional practice, however, E-Mail, voice, facsimile, and other message types can be retrieved by the computer." [Gordon at 6:46-50]

Gordon discusses the "advantages of the system which are particularly appropriate with respect to subscribers who travel and often are quite distant from their particular Unipost Access Node." [Gordon at 7:18 – 21] See also Gordon at 10:31 – 11:14. As such the subscriber, who is the recipient of the message, initiates the transfer of voice messages from a remote Unipost Access Node. See also Gordon at 6:34-57. This type of voice message transfer is "pulled" from a repository to a subscriber based on the actions of the receiver of the message. Messages are not "pushed" over a network based on the actions of the caller, or the sender of the message.

Gordon also discloses the use of the Internet to support live communication between a subscriber and a Unipost Access Node. For example, Gordon notes that "...

the Internet subscriber 12 could use the telephone set 29 to retrieve voice messages and possibly the voice summary of messages received and have them played back to him ... the example shown in FIG. 3 has allowed the subscriber 12 to form a relatively local connection using the public switched telephone network 10 to contact the Tokyo UniPost Access Node 6. This is then connected to the Toronto UniPost Access Node 6 and the electronic mailbox of the subscriber via an Internet or dedicated data communication channel.” [Gordon at 7:31-33, 43-47] Gordon also notes that “... voice is transmitted digitally and a live communication is maintained between Toronto UniPost Access Node 6 and Tokyo UniPost Access Node 6.” [Gordon at 8:64-67] Live communication over the Internet is based on establishing a “packet path between the originating UniPost Access Node and the destination UniPost Access Node closest to the recipient.” [Gordon at 9:13-15] Live communication such as this does not involve encoding a complete caller communication prior to transmitting such communication over a network, but involves transmitting voice packets during the user communication along the “packet path.” See also Gordon at 7:41-50.

In summary, Gordon discloses embodiments utilizing

(1) conventional telephone access to a voice mail system; these embodiments do not involve the transmission of voice messages, the messages are confined to a central repository,

(2) retrieval of messages responsive to the recipient of a message; these embodiments do not involve transmission of voice messages responsive to the sender of the message; and

(3) real-time communication of voice over a network; these embodiments do not involve transmission of voice messages over a network.

#### **Independent Claim 1 Is Not Anticipated by Gordon**

In contrast to the system disclosed in Gordon, embodiments of the present invention involve recording a complete caller communication prior to transmission over a network. After completion of a complete caller communication, the communication is

transmitted over a network responsive to a caller indication. In other words, voice messages are “pushed” over the network when sent. These embodiments do not relate to live communication over the Internet, and they do not relate to the transmission of complete voice messages responsive to the recipient of the message, that is the “pulling” messages over the Internet when they are played back.

Claim 1 as amended recites the generation of a digital message file that “comprises a complete caller communication” and the transmission of the digital message file “through said network after said voice encoding device completes the generation of said digital message file.” The portions of Gordon that disclose live communication do not anticipate these claim elements. A voice packet is not a complete caller communication, and as explained above, Gordon discloses a process by which an ongoing communication is established, not the creation of a complete caller communication followed by a transmission of the communication over a network.

Claim 1 as amended recites that the “transmission of said digital message file is responsive to a caller indication,” and that the reception of the digital message file is “responsive to said caller indication.” The portions of Gordon that relate to subscriber access to voice messages do not anticipate these claim elements. A subscriber in Gordon accesses their voice mailbox when convenient. Thus, these subscriber initiated downloads of voice messages do not involve transmission or reception of messages responsive to a caller indication. For at least these reasons, Claim 1 as amended is not anticipated by Gordon.

#### **Independent Claim 4 Is Not Anticipated by Gordon**

Claim 4 as amended recites a digital message file that “comprises a complete caller communication” and transmitting the digital message file over a network “after said step of encoding is completed.” The portions of Gordon that disclose live communication do not anticipate these claim elements. A voice packet is not a complete caller communication, and Gordon discloses a process by which an ongoing communication is established, not the creation of a complete caller communication followed by a transmission of the communication over a network.

Claim 4 as amended recites that the “step of transmitting is responsive to a caller indication,” and receiving “responsive to said caller indication.” The portions of Gordon that relate to subscriber access to voice messages do not anticipate these claim elements. A subscriber in Gordon accesses their voice mailbox when convenient. Thus, these subscriber initiated downloads of voice messages do not involve transmission or reception of messages responsive to a caller indication. For at least these reasons, Claim 4 is not anticipated by Gordon.

**Dependent Claims 2, 5, 31, 38, 45, 50, 53 – 55, 57, 58, 62 – 67 and 69 Are Not Anticipated by Gordon**

Dependent claims 2, 31, 45, 53, 55, 57, 63, 64 and 67 depend directly and indirectly from claim 1. For at least the reasons stated above with respect to claim 1, dependent claims 2, 31, 45, 53, 55, 57, 63, 64 and 67 are not anticipated by Gordon.

Dependent claims 5, 38, 50, 54, 58, 62, 65, 66 and 69 depend directly and indirectly from claim 4. For at least the reasons stated above with respect to claim 4, dependent claims 5, 38, 50, 54, 58, 62, 65, 66 and 69 are not anticipated by Gordon.

**(3) Rejection of claims 68 and 70 under 35 U.S.C. 102(e) over Gordon**

In the Office Action, the Examiner rejected claims 68 and 70 as being unpatentable under 35 U.S.C. §102(e) over U.S. Patent 5,608,786 to Gordon (“Gordon”). The Examiner cited to column 7, lines 18 – 55 of Gordon to support the anticipation of using destination information “to select said second access device.” [Office Action at 5]

**Dependent Claims 68 and 70 Are Not Anticipated by Gordon**

Claim 68 depends indirectly from claim 1 and claim 70 depends indirectly from claim 4. For at least the reasons stated above with respect to claims 1 and 4 dependent claims 68 and 70 respectively are not anticipated by Gordon.



Claim 68 recites that “destination information is used to select said second access device.” Gordon does not disclose the use of destination information to select the destination of a voice message prior to transmission of that voice message. In particular, the portion of the specification relied on by the Examiner relates to the retrieval of voice messages by playing them back over the internet.

The Examiner has failed to identify specifically what is considered to be destination information and fails to identify how such information is used to select the second access device. As such, the rejection of claims 68 and 70 should be withdrawn at least on the basis that the Examiner has failed to make a prima facie case for anticipation.

In particular, it is not clear what could constitute the destination information used to select a second access device in the embodiments disclosed in Gordon. Any destination information, to the extent such information exists in the embodiments disclosed in Gordon, is not used to select a second access device in the context of the claims. Claims 68 and 70 relate to embodiments in which a voice message is recorded on a first access device and then transmitted over a network to a second access device, which has been selected based on destination information associated with the voice message. Such an embodiment is not disclosed nor taught by Gordon.

Respectfully submitted,

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By: /Stephen Melvin/

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## H. CLAIMS APPENDIX

The claims on appeal are as follows:

### Listing of Claims:

1. (Rejected) A system for transmitting voice messages from a caller to a recipient over a network, said system comprising:

a first access device coupled to a network, said first access device comprising:

a voice encoding device configured to receive a first voice signal and generate a digital message file, wherein said digital message file comprises a complete caller communication;

a first storage device capable of storing said digital message file; and

a transmission device configured to transmit said digital message file through said network; wherein said transmission device transmits said digital message file through said network after said voice encoding device completes the generation of said digital message file, and wherein said transmission of said digital message file is responsive to a caller indication;

a second access device coupled to said network, said second access device comprising:

a receiving device configured to receive said digital message file from said transmission device, responsive to said caller indication;

a second storage device capable of storing said digital message file;

a delivery notification device configured to notify of the receipt of said digital message file, said delivery notification device being responsive to said caller indication; and

a voice decoding device configured to decode said digital message file and generate a second voice signal, wherein said voice decoding device decodes said digital message file after said receiving device completes the reception of said digital message file.

2. (Rejected) The system of claim 1 wherein said network comprises a packet-switched network.

3. (Canceled)

4. (Rejected) A method for transmitting voice messages from a caller to a recipient over a network, said method comprising:

receiving a first voice signal by a first access device;

encoding said first voice signal into a digital message file by said first access device, wherein said digital message file comprises a complete caller communication;

storing said digital message file on a first storage device in said first access device;

after said step of encoding is completed, transmitting said digital message file over a network, wherein said step of transmitting is responsive to a caller indication;

receiving said digital message file from said network by a second access device responsive to said caller indication;

storing said digital message file on a second storage device in said second access device;

notifying of the receipt of said digital message file responsive to said caller indication; and

after said step of receiving is completed, decoding said digital message file and generating a second voice signal.

5. (Rejected) The method of claim 4 further comprising the step of:

transmitting a voice signal from a caller voice device through a caller communication medium to said first access device.

6 – 30. (Canceled)

31. (Rejected) The system of claim 63 wherein said caller voice device is a telephone and said caller communication medium comprises a circuit-switched network.

32 – 37. (Canceled)

38. (Rejected) The method of claim 4 wherein said network comprises a packet-switched network.

39 - 44. (Canceled)

45. (Rejected) The system of claim 64 wherein said recipient voice device is a telephone and said recipient communication medium comprises a circuit-switched network.

46 – 49. (Canceled)

50. (Rejected) The method of claim 5 wherein said caller voice device is a telephone and said caller communication medium comprises a circuit-switched network.

51 – 52. (Canceled)

53. (Rejected) The system of claim 2 wherein said packet-switched network is the public Internet.

54. (Rejected) The method of claim 66 wherein said circuit-switched network is the public switched telephone network (PSTN).

55. (Rejected) The system of claim 31 wherein said circuit-switched network is the public switched telephone network (PSTN).

56. (Canceled)

57. (Rejected) The system of claim 45 wherein said circuit-switched network is the public switched telephone network (PSTN).

58. (Rejected) The method of claim 38 wherein said packet-switched network is the public Internet.

59 – 61. (Canceled)

62. (Rejected) The method of claim 50 wherein said circuit-switched network is the public switched telephone network (PSTN).

63. (Rejected) The system of claim 1 further comprising a caller voice device and a caller telecommunication medium, wherein said caller voice device is coupled through said caller telecommunication medium to said voice encoding device.

64. (Rejected) The system of claim 1 further comprising a recipient voice device and a recipient telecommunication medium, wherein said recipient voice device is coupled through said recipient telecommunication medium to said voice decoding device.

65. (Rejected) The method of claim 4 further comprising the step of:

receiving a voice signal by a recipient voice device through a recipient communication medium from said second access device.

66. (Rejected) The method of claim 65 wherein said recipient voice device is a telephone and said recipient communication medium comprises a circuit-switched network.

67. (Rejected) The system of claim 1 wherein destination information is received by said first access device before said transmission device transmits said digital message file.

68. (Rejected) The system of claim 67 wherein said destination information is used to select said second access device.

69. (Rejected) The method of claim 4 further comprising the step of: before said step of transmitting,

receiving destination information by said first access device.

70. (Rejected) The method of claim 69 wherein said destination information is used to select said second access device.

## **I. EVIDENCE APPENDIX**

None.

## J. RELATED PROCEEDINGS APPENDIX

None.